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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223439
Party	Plaintiff Stanley Logistics, LLC
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Date	08/24/2015
Attachments	JS Products.pdf(441805 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

STANLEY LOGISTICS, LLC

:

Plaintiff

:

v.

:

Opp. No. 91223439

JS PRODUCTS, INC.

:

Defendant

:

**RESPONSE TO BOARD ORDER
AND CERTIFICATE OF SERVICE**

In response to the Board's order, this is to certify that a true and correct copy of the attached notice of opposition was served upon Applicant on August 24, 2015, by depositing it with the U.S. Postal Service, marked first class mail, postage prepaid, and addressed to:

Mr. Johnny Mora
JS Products, Inc.
6445 Montessouri St.
Las Vegas, NEVADA 89113.

STANLEY LOGISTICS, LLC

By



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Attorney for Plaintiff

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86429073 for the mark PROTOCOL filed on October 20, 2014, and published on August 18, 2015.

Stanley Logistics, LLC

Opposer,

v.

JS Products Inc.

Applicant.

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Opposition No. _____

NOTICE OF OPPOSITION



Stanley Logistics, LLC, a limited liability company organized under the laws of Delaware, believes that it will be damaged by the registration of the mark PROTOCOL (the “Disputed Mark”), the subject of application Serial No. 86429073 (the “Application”) filed by JS Products Inc. (“JSP” or “Applicant”), a Nevada corporation with an address of 6445 Montessouri Street, Las Vegas, Nevada 89113. Stanley Logistics, LLC hereby opposes the Disputed Mark under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Stanley Logistics, LLC alleges as follows:

1. Stanley Logistics, LLC is a wholly-owned subsidiary of Stanley Black & Decker, Inc. (collectively “Stanley”). Stanley is renowned in the U.S. and around the world as a leading manufacturer and marketer of tools, tool kits, security products, lighting products, and a wide variety of other products.

2. For more than 65 years Stanley and its predecessors-in-interest have used the trademark PROTO, and marks that incorporate PROTO, in connection with hand and power

tools, tool storage products, and a wide variety of related goods and services. Stanley owns several federal trademark registrations for its PROTO marks, including the following:

Reg. No.	Reg. Date	Mark	Goods
0501030	July 13, 1948	PROTO	Pliers, end wrenches and sockets, in Class 8
0530257	Sept. 5, 1950	PROTO	Tools-namely, adapters, awls, utility bars, battery terminal pullers, bearing pullers, bending bars, box wrenches, brake spring plier, brake tools, cape chisels, chisels, cold chisels, connecting rod sockets, crowfoot wrenches, diamond point chisels, drag link tools, L handles, flare nut wrenches, flex handles, gear pullers, hacksaws, hinge handles, offset box wrenches, open end wrenches, pin handles, pinion puller bars, pipe extractors, pipe wrenches, pitman arm pullers, pneumatic wrench sockets, prick punches, pry bars, pullers, punches, ratchets, rim wrenches, ripping chisels, rivet cutters, rolling head bars, scrapers, screw extractors, screwdriver sockets, screwdrivers, socket handles, socket racks, socket wrenches, combination wrenches, star drills, stud pullers, torque wrenches, tubing expanders, universal joints, universal sockets, wheel pullers, wood chisels, wrench pliers, wrenches, in Class 6
0555093	Feb. 19, 1952	PROTO	Tools-namely-brake gauges, feeler gauges, ignition gauges, and thickness gauges, in Class 9
0889361	Apr. 14, 1970	PROTO	Compression testers, in Class 9
0954749	Mar. 13, 1973	PROTO	Containers for tools-namely, portable tool boxes, chests and cabinets, in Class 6
1739488	Dec. 15, 1992	PROTO	manually operated hand tools; namely, sockets, ratchets, universal joints, wrenches, torque wrenches, c-clamps, punches, pry bars, chisels, pliers, cutters, wire strippers, snips, utility knives, screwdrivers, nut drivers, hex bits and hex keys, hammers, pullers, saws, inspection mirrors, files and parts thereof, in Class 8; and feeler and thickness gauges and measuring instruments; namely, tape rules, in Class 9
4384740	Aug.13, 2013		Power impact wrenches and power torque drivers, in Class 7
4403918	Sept.17, 2013		Pneumatic wrench sockets, in Class 7; Hand tools, namely, awls, utility bars, battery terminal pullers, bearing pullers, bending bars, box wrenches, brake spring pliers, universal brake adjusting tools, cape chisels, chisels, cold chisels, connecting rod sockets,

			crowfoot wrenches, diamond point chisels, L handles, flare nut wrenches, flex handles, gear pullers, hacksaws, hinge handles, offset box wrenches, open end wrenches, pin handles, pinion puller bars, pipe extractors, pipe wrenches, pitman arm pullers, prick punches, pry bars, pullers, punches, ratchets, rim wrenches, ripping chisels, rivet cutters, rolling head bars, scrapers, screw extractors, screwdrivers, screwdriver sockets, socket handles, socket racks, socket adapter heads, drag link socket head adapters, wrenches, combination wrenches, star drills, stud pullers, torque wrenches, tubing expanders, universal joints, universal sockets, wheel pullers, wood chisels, wrench pliers, wrenches, pliers, end wrenches and sockets, in Class 8
4502145	Mar.25, 2014	PROTO	Metal containers for tools sold empty, namely, portable tool boxes and chests, in Class 6; Containers for tools, namely, portable tool boxes and chests sold filled with hand tools, in Class 8; Non-metal containers for tools sold empty, namely, portable tool boxes and chests; containers for tools, namely, cabinets, in Class 20
4384784	Aug.13, 2013	PROTO	Power impact wrenches and power torque drivers, in Class 7
4426057	Oct.29, 2013	PROTO (id)	Metal containers for tools sold empty, namely, portable tool boxes and chests, in Class 6
4396897	Sept. 3, 2013	PROTO (id)	Power impact wrenches and power torque drivers, in Class 7
4426058	Oct. 29, 2013	PROTO (id)	Pneumatic wrench sockets, in Class 7; Hand tools, namely, adapters to affix radio frequency identification chips to tools, awls, utility bars, battery terminal pullers, bearing pullers, bending bars, box wrenches, brake spring pliers, cape chisels, chisels, cold chisels, connecting rod sockets, crowfoot wrenches, diamond point chisels, L handles, flare nut wrenches, flex handles, gear pullers, hacksaws, hinge handles, offset box wrenches, open end wrenches, pin handles, pinion puller bars, pipe extractors, pipe wrenches, pitman arm pullers, prick punches, pry bars, pullers, punches, ratchets, rim wrenches, ripping chisels, rivet cutters, rolling head bars, scrapers, screw extractors, screwdriver sockets, screwdrivers, socket handles, socket racks, socket wrenches, combination wrenches, star drills, stud pullers, torque wrenches, tubing expanders, universal joints, universal sockets, wheel pullers, wood chisels, wrench pliers, wrenches, pliers, end wrenches and sockets, in Class 8

3. Many of these registrations are incontestable and provide *conclusive* evidence of Stanley's registration of the PROTO marks, Stanley's ownership of the marks, and of Stanley's exclusive right to use the marks in commerce on or in connection with the goods specified in the registrations.

4. Stanley's rights in the PROTO marks are senior to any trademark rights Applicant may claim in the mark PROTOCOL.

5. For decades Stanley has expended substantial resources and money marketing, advertising, and promoting the PROTO marks throughout the United States in connection with a wide range of hand and power tools, tool storage products, lighting products, and related goods and services.

6. By reason of its extensive marketing, advertising, and promotion, Stanley's PROTO marks have become uniquely associated with Stanley and serve as part of Stanley's identity with consumers.

7. Stanley's PROTO marks have become well-known and famous as distinctive indicators of the origin of Stanley's goods and services, and the PROTO marks are valuable symbols of Stanley's goodwill and identity.

8. The PROTO marks are fanciful, arbitrary, inherently distinctive, and therefore strong and entitled to a broad scope of protection.

9. Applicant has done business with Stanley and was aware of Stanley's PROTO marks when Applicant adopted its PROTOCOL mark but, notwithstanding Stanley's prior rights, Applicant is seeking to register the mark PROTOCOL for the following products:

Tables and stands specially adapted to hold powered machinery, powered tools, powered saws and powered machinery equipment, in Class 7

10. The mark PROTOCOL is substantially and confusingly similar to Stanley's

PROTO marks.

11. The goods identified in the PROTOCOL Application are highly related or identical to the goods Stanley provides under its PROTO marks, and the goods protected under Stanley's federal trademark registrations for the PROTO marks.

12. Stanley is not related to Applicant and has not authorized Applicant to use or register the Disputed Mark.

13. Stanley believes that it will be damaged by the registration of the Disputed Mark.

COUNT I – LIKELIHOOD OF CONFUSION – § 2(d)

14. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 13 above.

15. The mark PROTOCOL so resembles Stanley's PROTO marks that Applicant's use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's goods and will injure and damage Stanley and the goodwill and reputation symbolized by Stanley's PROTO marks.

16. Applicant's goods are highly-related or identical to the goods and services of Stanley such that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Stanley or that Applicant is in some way connected with, sponsored by, or affiliated with Stanley, all to Stanley's irreparable damage.

17. Likelihood of confusion is enhanced in this case by the fame of Stanley's PROTO marks and by the fact that consumers associate Stanley's PROTO marks with goods and services sold, approved, or endorsed by Stanley.

18. Likelihood of confusion is enhanced in this case by the fact that the parties' goods are marketed and sold through the same trade channels to the same purchasers and classes of

purchasers.

COUNT II – DECEPTION/FALSE SUGGESTION OF CONNECTION

19. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 18 above.

20. Applicant's mark PROTOCOL misdescribes the character, quality, function, composition or use of the applied-for goods; prospective purchasers are likely to believe that the misdescription actually describes the applied-for goods; and the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase.

21. Applicant's mark PROTOCOL falsely suggests a connection with Stanley because Applicant's mark is the same as, or a close approximation of, Stanley's PROTO name and/or identity; Applicant's mark would be recognized as such, in that it points uniquely and unmistakably to Stanley; Stanley is not connected with goods sold under Applicant's mark; and Stanley's fame and reputation is such that, when Applicant's mark is used with Applicant's goods and services, a connection with Stanley would be presumed.

22. Applicant's PROTOCOL mark is a close approximation of Stanley's PROTO name and identity.

23. When Applicant's mark is used on the goods covered under its application, Applicant's mark will cause purchasers to mistakenly assume that Stanley is endorsing, attempting to promote, or encouraging the sale of Applicant's goods by permitting Applicant's mark to be used in connection with such goods.

24. Applicant's mark PROTOCOL is deceptive in that it falsely suggests a connection with, or approval by, Stanley.

25. Applicant is not connected with Stanley and Stanley is not connected with any

activities performed by Applicant under Applicant's mark.

26. Use and registration of the mark PROTOCOL by Applicant will deprive Stanley of the ability to protect its reputation, persona, and goodwill.

27. Likelihood of damage to Stanley's goodwill is enhanced by the fact that many of the same customers and prospective customers will encounter both the PROTO and PROTOCOL marks and those that encounter defects in the quality of Applicant's goods will attribute those defects to Stanley, thereby injuring Stanley's reputation and goodwill.

COUNT III – DILUTION – § 43(c)

28. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 27 above.

29. Stanley's PROTO marks have been widely used and extensively publicized in the United States and have become well-known and famous within the meaning of the Lanham Act § 43(c) as a distinctive symbol of Stanley's goodwill.

30. Stanley's PROTO marks were well-known and famous before Applicant filed its application for or made any use of the mark PROTOCOL.

31. Applicant's conduct is likely to cause an association arising from the similarity between the marks PROTO and PROTOCOL that impairs the distinctiveness of Stanley's mark PROTO.

32. The use or registration of Applicant's mark PROTOCOL will tarnish the goodwill of Stanley's PROTO marks and lessen the capacity of Stanley's PROTO marks to identify and distinguish Stanley's goods and services.

33. Likelihood of confusion, dilution, and deception is further enhanced here by the

fact that the parties' goods will be advertised and provided through the same trade channels and to the same classes of prospective purchasers.

34. Likelihood of confusion, dilution and deception is further enhanced here by the fact that the goods covered under Applicant's PROTOCOL application are closely related or identical to those provided by Stanley under its PROTO marks.


35. By reason of the foregoing, Stanley asserts that it will be damaged by the registration of Applicant's mark PROTOCOL and hereby opposes the Application under 15 U.S.C. § 1052.

WHEREFORE, Stanley prays that this opposition be sustained and that registration be denied.

Respectfully submitted,

STANLEY LOGISTICS, LLC

Dated: August 20, 2015 By:


James R. Davis, II
ARENT FOX LLP
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Washington, D.C. 20006
(202) 857-6000

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that the foregoing Notice of Opposition regarding Application No. 86429073 is being served on Applicant's counsel

Paul G. Juettner
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via email as agreed upon, this 20th day of August, 2015.

A handwritten signature in dark ink, appearing to read "Juettner", is written over a horizontal line.